

REMARKS

REVIEW

The original application set forth claims 1-19 of which claims 1, 11 and 15 were independent claims. Pursuant to an election/restriction requirement, the present application sets forth original claims 1-10 and 15-19. Claims 11-14 have been withdrawn from consideration.

Presently, no claims have been indicated as allowed in view of the prior art. Claims 1, 2, 4, 5, 7, 9, 10, 15, and 16 stand collectively rejected under 35 U.S.C. § 102(b) as being anticipated by Peterson (U.S. Patent No. 5,722,793). Claims 3, 6, 8, and 17-19 stand objected to for their dependence from a rejected base claim but are indicated as allowable if rewritten in independent form. Both the specification and drawings stand objected to for multiple use of reference numbers to indicate differing elements of the present invention. Finally, the present Oath/Declaration as signed by the Applicant has been declared defective for the inclusion of an incorrect filing date of a provisional application to which the present application claims priority.

DRAWING OBJECTION

Applicant hereby submits a replacement drawing sheet for sheet 2 of 3 (including proposed corrected drawings marked in red for Figure 3) correcting the duplicative use of reference numbers 44, 46, and 48. Such reference numbers have been left in Figure 2 to indicate various physical locations within the water but have been changed in Figure 3 to reference numbers 45, 47, and 49, respectively, for indication of various components of the proposed fiber optic cable design. Applicant respectfully requests approval of the attached substitute drawing Figures.

SPECIFICATION OBJECTION

In response to the Examiner's notation of the repeated use of reference numerals 44, 46, and 48 within the specification for the identification of various elements of the present invention, Applicant's have above amended the specification to correct such error. Withdrawal of this ground of objection is earnestly solicited based on such amendments.

OATH / DECLARATION OBJECTION

To aid in correcting the unintentional error in the present defect, Applicant submits herewith a corrected Inventor's Oath/Declaration including the corrected information required.

35 U.S.C. § 102(b) REJECTION

With respect to the 35 U.S.C. § 102(b) rejection of claim 1-15, and in view of the distinctions discussed herein, Applicants respectfully traverse such ground of rejection with the above amendments and the following remarks. The present invention encompasses certain aspects that distinguish it from the proposed reference. It is respectfully submitted that the reference, Peterson, merely serves to demonstrate the patentability of Applicant's claimed invention. Specifically, Peterson fails to adequately disclose every element of the claimed invention and as such cannot serve at law as an anticipating reference to the present invention as now amended under 35 U.S.C. § 102.

Before setting forth a discussion of the prior art applied in the Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under 35 U.S.C. §

102. "For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986; emphasis added). Anticipation under 35 U.S.C. Section 102 requires that there be an identity of invention. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, ___, 225 U.S.P.Q. 635, 637 (Fed. Cir. 1985; emphasis added). In PTO proceedings, claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 U.S.P.Q. 385, 388 (Fed. Cir. 1983). The following analysis of the present rejections is respectfully offered with guidance from the foregoing controlling case law decisions.

Specifically, independent claims 1 and 15 each specify that the present invention is directed to a cable laying device for use underwater that includes a cable dispenser comprising an elongated stationary spool having a hollow central conduit through which said cable is dispensed at a precisely monitored and consistently maintained tension. It is respectfully submitted that Peterson fails to include such a feature in its design and therefore is inadequate to serve as a basis for a rejection of the present application under 35 U.S.C. § 102(b).

Based upon the above-described distinctions and the above amendments, it is respectfully submitted that claims 1, 2, 4-10, 15, 16, 18, and 19 are now in condition for allowance and acknowledgement of the same is earnestly solicited.

CLAIM OBJECTIONS

Based on the above amendments and arguments herein, Applicant respectfully submits that the present ground of objection to claims 3, 6, 8, and 17-19 are moot and withdrawal of such grounds of rejection are earnestly solicited.

CITED RELEVANT PRIOR ART

It is not believed that any of the prior art cited either by the Examiner or the Applicant, alone or in combination either with each other or other cited prior art teaches, discloses, suggests or makes obvious the claimed features of the present invention.

CONCLUSION

In view of the foregoing amendments and comments, Applicants respectfully request withdrawal of the current grounds of rejection and the issuance of a formal Notice of Allowance. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this amendment in order to permit early resolution of the same.

Respectfully submitted,

3/30/04
Date

Charles R. Ducker Jr.
Charles R. Ducker, Jr.
Reg. No. 46,542

LANIER FORD SHAVER & PAYNE P.C.
Customer Number 021491
P.O. Box 2087
Huntsville, Alabama 35804-2087
Phone: (256) 535-1100
Fax: (256) 533-9322

Certificate of Mailing under 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope address to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 30, 2004.

Charles R. Ducker Jr.
Signature

Charles R. Ducker, Jr.
Printed Name of Person Signing Certificate